

08-01-05

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

U.S. Patent 6,899,636
Issued: May 31, 2005
Inventor: Charles A. Finn
Title: GOLF PUTTER HAVING SPACED WEIGHT MEMBER
Serial No.: 09/934,967
Filed: August 22, 2001
Customer No.: 29955

Docket: 01-2827-64
Date: July 29, 2005

Mail Stop PATENT PETITION
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

**REQUEST FOR RECONSIDERATION OF PATENT
TERM ADJUSTMENT UNDER 35 U.S.C. 154(b)**

This is a request for reconsideration of the patent term adjustment indicated in the Notice of Allowance in the above patent application, which was 25 days. The requirements set forth in 37 C.F.R. 1.705(d) appear below.

1. The \$200 fee set forth in §1.18(e) is enclosed.
2. The correct patent term adjustment under §1.702(a) is believed to be no less than 9 months, 9 days

(i) (b) Issue date 5-31-05 (-) filing date + 3 years = 8-22-04

5-31-05 (-) 8-22-04 = 9 months, 9 days

(1), (2), (3), (4) No continued examination under 35 U.S.C.
132(B)

- (5) No interference, no secrecy order, no appeal
delay by applicant - 1 month extension of time
(-) 1 month
(c), (d), (e) no interference proceedings, no
secrecy order, no appeal

Correct adjustment is no less than 9 months, 9 days

(ii) Relevant dates specified in §1.703(a) through (e)

- (a) Filing date plus 14 months 10-22-02

First Office Action under 35 U.S.C. 132, namely, a six-way
restriction requirement 2-4-03 = 3 months, 15 days (included in
9 months 9 days above)

The first Office Action on the merits was issued 4-22-03 = 6
months, 0 days (not included in 9 months, 9 days above)

(1), (2), (3), (4) Not applicable.

(c), (d), (e) Not applicable.

(iii) Application is not subject to a terminal disclaimer.

The applicant and his attorney diligently prosecuted the application by
responses within three months in the face of two final rejections both of
which were ultimately withdrawn by the Examiner's Supervising attorneys.
The Examiner had these different supervisors during the prosecution of
this application. In response to one rejection, the applicant who is

confined to his home and receiving oxygen virtually continuously and his attorney obtain declarations supporting the patentability of all pending claims from four experts: Dr. Robert Brodsky and Mr. James Olliff from the scientific side and Dr. Tim Somerville and Mr. Kent Brown, golf school experts provided convincing proof of novelty from the golf standpoint. This required more than the three months to complete and a one-month extension was required for that effort and amendment preparation.

After filing these declarations and a personal interview by two attorneys with the Examiner and his supervisor, all pending claims were allowed.

The applicant should not be penalized in overcoming two admitted erroneously issued final rejection and 17 months before any action on the application.

- (iv) (A) While applicant found it necessary to request a one-month extension of time to procure declarations, this was not believed to constitute "failure to engage in reasonable efforts to conclude processing or examination of the application". So there should not be any (-) 1 month.
- (C) (2) Applicant is believed to be entitled to count this one month extension as part of the 9 months, 9 days due him because

of taking more than three years for prosecution. Factors causing this excessive prosecution time and the need for a one-month extension of time are that, in spite of all due care, the prosecution was unduly delayed because of the following:

- (a) The first Office Action dated 2-4-03, which was a requirement for restriction, issued 17 months after the filing date, 8-22-01. A Petition to Make Special because of applicant's health was granted 10-9-02. (It is also noted that a competitor's application for a patent on a similar product, filed five months later, then the Finn application was examined by the same Examiner issued in about less than two years (U.S. Patent 6,663,497 B2 filed 1/22/02, issued 12/16/03). The applicant suffered two erroneous final rejections and initial 17 months before action totaling 3 years 9 months for the patent to issue.
- (b) In a first Final Action dated 9-17-03, Examiner rejected all claims. A subsequent 37 CFR 1.116 amendment was not entered for purposes of appeal.

- (c) Interview with Supervisory Examiner Gregory Vidovich by telephone 1-8-04. Following the telephone interview, an Office Action by the Supervisory Examiner of 2-25-04, allowed claims 20-22, 26, and 27 withdrawing the final rejection. All other claims were rejected.
- (d) Following second 37 C.F.R. 1.116 amendment dated 1-16-04, in the next Office Action dated 3-23-04, all claims were again rejected by the Examiner but prosecution was reopened. The final rejection dated 9-17-2003 was also withdrawn.
- (e) Amendment of 8-25-04 was filed enclosing four truly expert declarations plus other extensive material supporting the novelty of this invention.
- (f) An interview was held with Examiner Duong and Supervisory Examiner Caldera by Attorneys John E. Wagner and Hayden Carney 10-26-04.
- (g) All pending claims allowed in Office Action dated 1-11-05 covering five of the six species originally restricted.

In view of telephone interviews with both of Supervisory Examiners Vidovich and Glenn Caldera overriding the Examiner's opinion as to patentability with Examiner Duong, and the subsequent allowance of substantially all pending claims, there is little doubt that the application would have been allowed by the U.S. Patent and Trademark Office Board of Patent Appeals and Interferences.

The application was proceeding on a "Make Special" basis because of applicant's ill health. The time for processing an appeal was, at the time, uncertain but thought to be in the order of two years. Applicant's attorney was therefore making every effort short of filing an appeal to secure an allowance of the claims. It is, therefore, believed that the one-month extension requested for responding to the Office Action dated 12-27-03 was entirely justified by the efforts required to assemble the declarations which were thought necessary to support applicant's position.

It is further submitted that a reasonable period for prosecution of this application would be no more than 24 months so that a proper and equitable term extension should be 21 months, 9 days. This is slightly longer than that of the prosecution period for the later filed, earlier issued related patent 6,663,497 cited above.

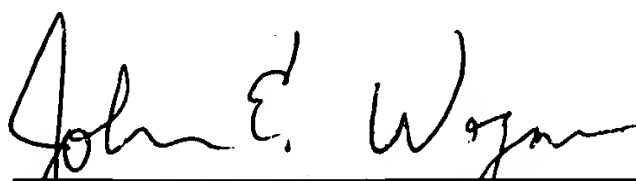
A review of the U.S. Patent and Trademark Office web site and actual patents show the Examiner approved 22 out of 25 later filed golf patent applications which issued prior to this Finn (made special) patent. For some unknown reason, this "made special" application was not treated in accordance with its "made special" status and the

philosophy behind patent term extension.

Accompanying this petition is a Declaration of the undersigned in support of this Petition. It contains Exhibits 1(a)-(d), a recap of communications during most of the prosecution history of this patent showing continued due diligence.

Also accompanying this request is a check in the amount of \$200 and authorization is made to charge any additional amounts of Deposit Account 23-0083. However, it is sincerely believed that the delays were due to occurrences in the U.S. Patent and Trademark Office and that the individual inventor, Finn, should not properly be required to make fee payments in this matter. It appears similar to the matter of correction of patents where the error is in the U.S. Patent and Trademark Office. Granting this petition and a refund of \$200 and any additional fee is therefore requested.

Respectfully submitted,



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JW:RCS:mm

Enclosures